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EXAMINER				
HARVEY, DAVID E				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/586,554

Applicant(s)

CASACCIA ET AL.

Examiner

DAVID E. HARVEY

Art Unit

2481

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 2481

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/2010 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) For the record:

1) The examiner notes that, in addition to the "means for ..." terminology, the following non-exhaustive list of non-functional terms may likewise invoke Section 112-6:

- a) "mechanism for ...";
- b) "module for ...";
- c) "device for ...";
- d) "unit for ...";
- e) "component for ...";
- f) "element for ...";
- g) "member for ...";
- h) "apparatus for ..."
- i) "machine for...";
- j) "system for ...";

k) etc,...

It is noted, however, that "circuit for" has been determined to be a "structural term" that does not invoke section 112-6.

[e.g., SEE: Federal Register/Vol.76, No. 26/Wednesday, February 9, 2011 @ first full paragraph of center column on page 7167];

2) For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer or microprocessor.¹ The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor.² The written description of the specification must at least disclose the algorithm that transformed the general purpose microprocessor to a special purpose computer programmed to perform the claimed function.³ Applicant may express the algorithm in any understandable terms including as a mathematical formula, in prose, in a flow chart, or in any manner that provides sufficient structure.⁴

B) With respect to claim 17:

1) The "**means....**" recited in claim 17 are means plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function for each of the recited means. Applicant is required to:

- 1) Amend the claim so that the claim limitation will no longer be a means plus function limitation under 35 U.S.C. 112, sixth paragraph; or

¹ See *Aristocrat Technologies Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d. 1235, 1239-1240 (Fed. Cir. 2008)

² See *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d. 1385 (Fed. Cir. 1999)

³ See *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d. at 1243.

⁴ See *Finisar Corp. v The DIRECTV Group Inc.*, 523 F.3d 1323, 1340, 86 USPQ2d. 1385 (Fed. Cir. 1999)

Art Unit: 2481

2) Amend the written description of the specification such that it clearly links or associates specific structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

3) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

4. Claims 15-16 are objected to because of the following informalities:

A) They appear to be duplicates/repeats of claim 5-6.

Appropriate correction is required.

Art Unit: 2481

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,758,712 to Hudson in view of**

A) US Patent #5,262,865 to Herz:

B) US Patent Document #2004/0036632 to Ford; and

C) US Patent #6,452,612 to Holtz et al.:

I. **Preface:**

It continues to be the examiner's position that the recitations of claim 1 can be broadly construed because the claim fails to distinguish and/or give specific meaning to the following terminologies:

A) "plurality of states of at least one production device" wherein each state corresponds to at least one "executable operation"⁵

B) "memory objects"⁶ and

C) "manifests a status"⁷

II. **As to the showing of Hudson:**

Hudson has been cited because it illustrates a special effects video production device which comprises a physical control panel, shown in Figure 12, which includes:

1) A plurality of buttons/**actuators** (e.g., @ 910) which are used to select a plurality of **operating states** of at least one production device (i.e., a wipe effect generator);

wherein the button includes:

A) A "icon"/label attached thereto which gives a physical indication of the operating state of the at least one production device; and

B) At least implicitly [e.g., note lines 48-55 of column 41], an interlocked arrangement which allows only one of the buttons to be depressed at any given time thereby

⁵ The examiner maintains that such "states" and "operations" broadly/fairly encompass a device being: turned on; turned off; activated; non-activated; selected; non-selected; set/configured/programmed to perform a given operation; etc,...

⁶ The examiner maintains that "memory objects" broadly/fairly reads on any stored data that is used for identifying the "states" and "operations" of a production device for actuation thereof.

⁷ The examiner maintains that "manifests a status" broadly/fairly read on an indication/display of such a status

manifesting the operating state/status of the at least one production device; i.e., the button that is currently depressed indicates the current user selected operating state/status of the production device.

III. Obviousness:

A. US Patent #5,262,865 to Herz:

Herz has been cited as evidencing the fact that it was known for physical control panels, of the type described by Hudson, to have been expanded to include additional buttons/actuators for selecting one of different operating states of additional production devices [i.e., Note: element 110 of Figure 1b; and lines 28-60 of column 1].

Given this showing the examiner maintains that it would have been obvious to one of ordinary skill in the art to have modified the systems disclosed by Hudson to include additional production devices and additional buttons/actuators for controlling the states/operation thereof; i.e., thereby advantageously expanding the effects capabilities of the system beyond wipes.

B. US Patent Document #2004/0036632 to Ford and US Patent #6,452,612 to Holtz et al.:

Ford has been cited as evidencing the fact that it was notoriously well known in the physical control panel art to have utilized a limited number of physically buttons/actuators to select a more numerous number of operating states/function by making the buttons/actuator programmable; including the icon/label "attached"/displayed thereon [e.g., note paragraphs 0002, 0009, and 0010]. As shown in Figure 9, Holtz et al evidences that it was known to have utilized such programmable buttons/actuators on the control panel of video production systems [e.g., Note lines 29-46 of column 18].

Given these showings the examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the modified system of Hudson to have included comprised programmable keys; i.e., thereby advantageously reducing the number of key required to provide the various effects.

The examiner maintains that such a modified systems meets the limitations of claim 1 given a broad/fair reading of the recited terminology as set forth above in part "I." of this paragraph.

7. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,758,712 to Hudson in view of

A) US Patent #5,262,865 to Herz:

B) US Patent Document #2004/0036632 to Ford; and

C) US Patent #6,452,612 to Holtz et al.:

for the same reasons that were set forth above for claim 1. Additionally:

The examiner takes Official notice that the devices recited in claims 2-4 comprise notoriously well known production devices. It would have been obvious to have incorporated such well known devices within the expanded/modified production system of Hudson.

8. Claims 5-6 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,758,712 to Hudson in view of

A) US Patent #5,262,865 to Herz:

B) US Patent Document #2004/0036632 to Ford; and

C) US Patent #6,452,612 to Holtz et al.:

for the same reasons that were set forth above for claim 1.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,758,712 to Hudson in view of

A) US Patent #5,262,865 to Herz:

B) US Patent Document #2004/0036632 to Ford; and

C) US Patent #6,452,612 to Holtz et al.:

for the same reasons that were set forth above for claim 1.

10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,758,712 to Hudson in view of

A) US Patent #5,262,865 to Herz:

B) US Patent Document #2004/0036632 to Ford; and

C) US Patent #6,452,612 to Holtz et al.:

for the same reasons that were set forth above for claim 17. Additionally:

The examiner takes Official notice that the devices recited in claims 2-4 comprise notoriously well known production devices. It would have been obvious to have incorporated such well known devices within the expanded/modified production system of Hudson.

11. US Patent #7,020,381 to Kato et al has been noted for its showing of Figure 4 (i.e., @ elements 44 and 46) and Figure 9 (i.e., @ 62 and 72).

Art Unit: 2481

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Peter-Anthony Pappas, can be reached on (571) 272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2481

DAVID E HARVEY

Primary Examiner

Art Unit 2481